

II. Rejection under 35 U.S.C. § 102(b)

Claims 1-4 and 19-29 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,900,545 ("*Wisotzki*") for the reasons set forth on pages 3-4 of the present Office Action. Applicants respectfully traverse this rejection.

A rejection under § 102 is only proper when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972); *see also* M.P.E.P. § 706.02(a) ("For anticipation under 35 U.S.C. § 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly.").

In response to Applicants' assertion that *Wisotzki* does not teach a method of protecting a keratinous fiber from extrinsic damage or a method of repairing a keratinous fiber following extrinsic damage, the Examiner directs Applicants to col. 1, lines 5-10 of *Wisotzki*, "wherein the reference teaches that its compositions are used for the caring and revitalizing of mistreated hair, including the regeneration of hair damaged by split ends." See page 2 of the present Office Action (emphasis added).

However, according to the present application, "protected" means that the keratinous fibers demonstrated a greater degree of preservation of the α -structure and the tensile strength. See page 5 of the present application. Further, "repairing" means that the damaged keratinous fibers demonstrated an increase in α -structure

and/or tensile strength following treatment of the damaged keratinous fibers with the compositions of the invention. See page 5 of the present application.

With respect to the definitions given in the specification of the application, the Examiner asserts that "although the claims are read in view of the specification, limitations are not read into the body of the claim." See page 3 of the present Office Action. However, Applicants are not attempting to introduce limitations into the claims. Rather, Applicants are merely asserting that the claims must be construed according to the explicit definitions which are found in the specification. Patent law permits the patentee to choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning. Mycogen Plant Science v. Monsanto Co., 243 F.3d 1316, 1327, 58 U.S.P.Q.2d 1030, 1039 (Fed. Cir. 2001) ("[A] patentee is free to be his own lexicographer, so long as the special definition of a term is made explicit in the patent specification or file history."). Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 U.S.P.Q.2d 1065, 1069 (Fed. Cir. 1999). Accordingly, in the present case, the explicit definitions of "protected" and "repairing" in the specification control the interpretation of these terms as they are used in the claims.

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Nowhere in the document does *Wisotzki* teach or suggest a method for "protecting" a keratinous fiber from extrinsic damage or a method of "repairing" a keratinous fiber following extrinsic damage as defined in the present specification. As discussed in their Amendment filed November 29, 2001, *Wisotzki* merely teaches the reduction of the number of visually discernible split ends and does not teach or suggest preservation of or an increase in α -structure and/or tensile strength of the hair. *Wisotzki* discusses the visual characteristics of the hair (see e.g., col. 1, lines 29-30 reciting "restore damaged hair to a healthy appearance") whereas the present application is concerned with the α -structure and/or tensile strength of the hair.

With respect to claims 30-56, Applicants assert that *Wisotzki* does not teach heating the keratinous fiber, wherein the composition is applied prior to or during heating. Accordingly, for at least this additional reason, Applicants maintain that the claims 30-56 are not anticipated by *Wisotzki*.

For at least the foregoing reasons, Applicants assert that *Wisotzki* does not identically describe the subject matter of the present claims and thus, Applicants respectfully request that the rejection under 35 U.S.C. § 102 be withdrawn.

III. Rejections under 35 U.S.C. § 103(a)

Claims 1-56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Wisotzki*, U.S. Patent No. 5,660,838 ("*Koga*"), U.S. Patent No. 5,641,477 ("*Syed*"), and U.S. Patent No. 5,866,111 ("*Felardos*") for the reasons set forth on

pages 4 - 5 of the present Office Action. Applicants respectfully traverse this rejection for the reasons discussed above with respect to the rejection under 35 U.S.C. § 102 (*i.e.*, *Wisotzki*, the primary reference, does not teach or suggest a method of protecting a keratinous fiber nor a method of repairing a keratinous fiber according to the present invention) as well as the reasons discussed below.

One criteria that the Examiner must demonstrate to establish a *prima facie* case of obviousness is that there is some suggestion or motivation, either in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine reference teachings. In the present case, the Examiner has failed to demonstrate the requisite suggestion or motivation to make the proposed combination.

With respect to the limitation of claims 30-65 reciting heating the keratinous fiber, the Examiner asserts that "*Wisotzki* teaches that its compositions may be in the forms of permanent wave setting lotions. It is notes [sic] that heat is commonly utilized in waving formulations." Applicants find no support for this statement in *Wisotzki* and respectfully request that the Examiner provide evidence of such a common use so that Applicants may respond to this assertion.

With respect to the requisite motivation or suggestion to combine the cited references, the Examiner responds to Applicants' assertions by stating that:

[t]he present claims are drawn to the protection of and repairing of hair from *any* extrinsic force. All of the references cited, teach the benefits associated with sugars used in hair care compositions (protecting hairs against split ends, increasing tensile strength and reducing damage during harsh treatments). Applicant's [sic] claims

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are drawn generally to the protection and repairing of hair, and therefore, it remains the examiner's position that the combination of references is proper in view of the broad claim language.

See page 5 of the present Office Action (emphasis added).

First, it is a well established principle of patent law that the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991) (emphasis added). The Examiner's express reliance on the present claims violates this principle and such hindsight reasoning cannot be used as a substitute for the requisite motivation or suggestion to combine the cited references. Accordingly, for at least this reason, Applicants maintain that the Examiner has failed to establish a prima facie case of obviousness.

Second, Applicants respectfully note another principle of patent law, namely that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) (emphasis in original). In the present case, there would have been no motivation or suggestion to combine the cited references. Accordingly, the Examiner's assertion that "[a]ll of the references cited, teach the benefits associated with sugars used in hair care compositions (protecting hairs against split ends, increasing tensile strength and reducing damage during harsh treatments)" is immaterial in light of the fact that the cited references do not also suggest the desirability of combination. Accordingly, for at least this additional reason,

Applicants maintain that the Examiner has failed to establish a prima facie case of obviousness.

Finally, Applicant respectfully reminds the Examiner that if a rejection is maintained in view of Applicant's arguments, the Examiner should take note of Applicant's arguments and answer the substance of them. See M.P.E.P. § 707.07(f). Accordingly, if the Examiner decides to maintain this rejection, Applicants respectfully request that, at least, the Examiner clearly set forth basis for the requisite motivation or suggestion to combine the cited references and for the requisite reasonable expectation of success in making such a combination.

At least for the foregoing reasons, Applicants respectfully request withdrawal of this § 103(a) rejection.

IV. Conclusion

Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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